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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,313	03/20/2001	Sean E. Carolan	2000-0296B	2925

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EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812,313

Applicant(s)

CAROLAN ET AL.

Examiner

Beemnet W Dada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-7.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-6 have been examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Monachello et al. (Hereinafter Monachello) (US Patent No. 6,748,439 B1).

4. As per claims 1 and 6, Monachello teaches a method of configuring a network access device having a first network address allocated to a subscriber of services of the first service provider provided by a first service network, with a new network address allocated to a subscriber of services of a second service provider provided by a second service network, wherein the network access device is connected to an access network connected to a plurality of service networks, comprising the steps of:

displaying a plurality of service provider selections on a graphical user interface [column 3, lines 53-64];

in response to a subscriber selection on the graphical user interface, sending

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request from the network access device to the access network requesting a change to a second service provider [column 3, lines 53-67 and column 4, lines 1-21];

receiving a response from the access network [column 4, lines 21-34]; and

initiating a network address change request using a DHCP configuration protocol, whereby a second network address allocated to the subscriber of services of the second service provider is assigned to the network access device, the second network address being utilized by the network access device to communicate data packets to the service network providing the selected service [column 5, lines 9-27 and column 17, lines 62-67 and column 18, lines 1-17].

5. As per claim 2, Monachello teaches the method as applied above. Furthermore, Monachello teaches the method, wherein said request to said access network includes an authentication request for the subscriber [column 4, lines 27-35].

6. As per claim 3, Monachello teaches the method as applied above. Furthermore, Monachello teaches the method, wherein said response received from said access network includes an authentication status for the subscriber from the second service provider and, if authenticated, initiating said network address change request [column 4, lines 23-38].

7. As per claim 4, Monachello teaches the method as applied above. Furthermore, Monachello teaches the method, wherein the host configuration protocol is a dynamic host configuration protocol (DHCP) [column 5, lines 9-13].

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8. As per claim 5, Monachello teaches the method as applied above. Furthermore, Monachello teaches the method wherein the network access device receives an Internet Protocol address [column 5, lines 9-18].

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-6 of copending Application No. 09/812,315 (US 2001/0049729). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1-6 correspond to claims 1-6 of the copending application claims, except in the instant claims 1 and 6, the element displaying service provider selections on a graphical user interface and in response to a subscriber selection sending a request is referred in the copending application claims 1 and 6, as displays a plurality of service provider choices and selecting a service provider and sending a request . It

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would have been obvious to one having ordinary skill in the art to recognize that receiving a subscriber selection and sending a request is equivalent to sending a request in response to a subscriber selection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (703) 305-8895. The examiner can normally be reached on Monday - Friday (8:30 am - 6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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